The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> JAKOB NIELSEN

Appeal No. 2001-2297
Application No. 08/865,841

ON BRIEF[1]

Before BARRETT, DIXON, and LEVY, <u>Administrative Patent Judges</u>.

LEVY, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-26, which are all of the claims pending in this application.

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[1] The Oral Hearing scheduled for September 19, 2002 was waived by appellant in a communication, received via facsimile, on July 24, 2002.

BACKGROUND

Appellant's invention relates to adaptive meta-tagging of websites. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. Computer apparatus for information retrieval, comprising:

a. a bus;

b. information storage accessible through said bus;

c. a communications interface connected to said bus; and

d. a processor connected to said bus, said processor configured to receive search queries over said communications interface, to process those queries against information stored in information storage, and to provide a list of terms used in search queries presented over a period of time to be selectively added to information stored in information storage.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Brunner et al. (Brunner)   5,550,971   Aug. 27, 1996

Claims 1-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Brunner. Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 10, mailed July 28, 1999) for the examiner's complete reasoning in support of the rejection, and to appellant's brief (Paper No. 9, filed July 17, 1999) for appellant's arguments

thereagainst. Only those arguments actually made by appellant

have been considered in this decision. Arguments which appellant

could have made but chose not to make in the brief have not been

considered. See 37 CFR 1.192(a).

<div align="center">OPINION</div>

In reaching our decision in this appeal, we have carefully

considered the subject matter on appeal, the rejection advanced

by the examiner, and the evidence of anticipation relied upon by

the examiner as support for the rejection. We have, likewise,

reviewed and taken into consideration, in reaching our decision,

appellant's arguments set forth in the brief along with the

examiner's rationale in support of the rejection and arguments in

rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm-in-

part.

To anticipate a claim, a prior art reference must disclose

every limitation of the claimed invention, either explicitly or

inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d

1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666

F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v.

Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939))

(internal citations omitted):

Inherency, however, may not be established by
probabilities or possibilities. The mere fact that a
certain thing may result from a given set of
circumstances is not sufficient. If, however, the
disclosure is sufficient to show that the natural
result flowing from the operation as taught would
result in the performance of the questioned function,
it seems to be well settled that the disclosure should
be regarded as sufficient.

We consider first the rejection of claim 1 based on the

teachings of Brunner. Appellant asserts (brief, page 6) that the

examiner has not shown where Brunner teaches or suggests adding

terms from a query to the information stored, such as a database.

Appellant further argues (id.) that "the Examiner has not shown

where Brunner teaches or suggests that 'terms used in search

queries . . . be selectively added to the information stored.'"

The examiner's position (answer, page 5) is that the storage

and processing of query requests is shown by internal query

language processor 22 together with the semantic model 24. The

examiner argues (answer, page 7) that Brunner teaches in figure 6

and col. 18, line 60, et seq. loading the query into database

query language [processor] and storing the result; see element

266.

As stated by the Court in In re Hiniker Co., 150 F.3d 1362,

1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the

game is the claim." Claim 1 recites "provide a list of terms

used in search queries presented over a period of time to be selectively added to information stored in information storage."

From the language of claim 1, we find that the claim language requires that a list of items used in search terms over a period of time is provided, and that items from the list of search terms are selectively added to the information stored in the information storage. However, claim 1 does not specifically define the information storage. Although appellant is referring to the storage containing the information that the queries are processed against, the language of the claim is broad enough to read on the local cache database of Brunner, and does not require that the search queries presented over a period of time are stored in remote search database 264 of Brunner. In addition, we find that the period of time recited in claim 1 is not specifically defined, and is broad enough to read on a search and a modified or narrowed search made by a user.

From our review of Brunner, we find that Brunner is directed to generating a user interface for a database management system (col. 1, lines 18-20). Brunner discloses that the ability to effectively use and interpret all the information stored in a database can give a company an edge over its competitors (col. 1, lines 32-35). Systems typically have their own unique query

language that not only depends upon the architecture of the

database, but can also vary according to the manufacturer of the

database management system. Before a user can store and retrieve

data, it is often necessary to learn how to use the particular

user interface and/or the particular query language provided by

the manufacturer (col. 1, lines 40-52). The biggest impediment

to creating database interfaces is the fact that the computer

software that generates the user interface is coupled to the

structure of underlying data stored in the database. Once the

architecture has been defined, if the data structure of the

database is changed, the software that generates the user

interface must be recoded and recompiled to reflect the change in

the database structure (col. 2, lines 1-18). It is an object of

Brunner's invention to have a system that generates a user

interface that is adaptable to various database systems

regardless of the databases's query language or underlying

modeling constraints (col. 2, lines 55-59). As shown in figure

1, the queries are sent from a local/networked computer system

to a remote database 12. col. 4, lines 19-26). The queries are

written in the remote database's own query language (col. 4,

lines 27 and 28). System 14 includes a local cache database 26

(col. 53 and 54). SQL translator 28 converts query constraints

entered into the user database into the query language of the

remote database 12 (col. 5, lines 2-4). Figure 2 illustrates the

semantic data model used to generate the user interface. The

semantic model is separated into three distinct layers: the meta-

meta-model layer, the meta-model layer, and the model layer, all

of which describe the architecture of the data stored in the

remote database (col. 5, lines 20-26). After creating the model

layer, the data layer must be populated (col. 15, lines 1 and 2).

Once the three layers have been created and populated, the

present invention interrogates the model to determine how the

user interface should be generated. Although the preferred

embodiment of the user interface is graphical, as shown in figure

4, it could be text-based (col. 15, lines 28-36). In operation,

if the system is operating in a local mode, the data to be

searched have previously been stored in the local cache database.

If not, the remote database is searched. If the system is not

operating in a local mode, the query constraints are translated

into the remote database's own query language (figure 6, step

262). The remote database is searched at step 264 and the

results are loaded into the cache database at step 266 (col. 18,

line 57-64).

From our review of Brunner, we find that the search terms

provided by a user, where more than one search query is made,

will be stored in the local cache database 266, and that the

search query will also be stored in the local cache database. In

addition, from the disclosure of Brunner (col. 4, lines 54-60)

that

> This local cache database is used for two purposes.
> First, the local cache database is used to store the
> search results of queries received from the remote
> database 12. If the query constraints that produced
> the search results are narrowed, it is more efficient
> to only search the data stored in the local cache
> database 26 rather than performing a new search on the
> remote database 12

we find that the revised or narrowed search queries will be

stored in the local cache database. While the search queries are

not stored in the remote database 12, storage in the remote

database is not required by claim 1. However, claim 1 also

requires "selectively" adding to the information stored in

information storage, search queries from the list of search

queries presented over a period of time. Terms in claims are to

be given their ordinary and accustomed meaning, unless it appears

that the inventor used them differently. Envirotech Corp. v. Al

George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir.

1984). See also Hoechst Celanese Corp. v. BP Chems. Ltd., 78

F.3d 1575, 1578, 38 USPQ2d 1126, 1129 (Fed. Cir. 1996). From the
specification, we find that appellant (page 15) has used the term
"selected" consistent with its ordinary meaning. The term
"selection[2]" is defined as "a group from which a choice may be
made." From the definition of "selection" we find that the term
refers to selecting from between none to all of the search
queries presented over a period of time. Including all of the
search queries in the local database in not the same as having a
mechanism for selecting from the list of search queries.
Although "selectively" includes selecting all of the search
terms, which Brunner does by including the search queries of a
user in the local data base 266, we find that Brunner does not
include any mechanism for selecting search queries from among the
list to be added to the information storage.   Because Brunner
does not disclose a selecting mechanism, we find that Brunner
does not meet all of the limitations of claim 1. Accordingly,
the rejection of claim 1, and claims 2 and 3, dependent
therefrom, under 35 U.S.C. § 102(e) is reversed. As independent
claims 4, 7, 13, and 23 also require selecting from the list of

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[2] <u>Random House College Dictionary</u>, © Random House, 1973.

search queries, the rejection of claims 4, 7, 13, and 23, and

claims 5, 6, 8-12, dependent therefrom, are also reversed.

We turn next to independent claim 14. Claim 14 requires,

inter alia, "adding to documents containing those terms (queries)

as a meta-tag. The examiner's position (answer, page 5) is that

the adding of a term or query as a meta-tag is shown by the meta

model layer of figure 2 of Brunner and is disclosed on col. 5

line 21 et seq. of Brunner.

From our review of Brunner, and in particular the portion of

Brunner relied upon by the examiner, we find no disclosure of

putting meta-tags on search queries. Brunner disclose (col. 5,

lines 52-60) that the meta-model layer is an abstract description

of the various object types and relationships between the object

types that are stored in the particular remote database being

modeled, and is one of the layers that describe the architecture

of the data stored in the remote database. A meta-layer is not

the same as a meta-tag. We find no teaching in Brunner, and no

teaching of the use of storing the queries with meta-tags has

been provided by the examiner. Accordingly, we find that the

examiner has failed to establish a _prima facie_ case of

anticipation of claim 14. The rejection of claim 14, and claims

15-17, dependent therefrom, under 35 U.S.C. § 102(e) is therefore

reversed. As independent claims 18, 21, 24, and 26 also recite

meta-tags, the rejection of independent claims 18, 21, 24, and

26, and claim 22, dependent from claim 21, are reversed.

We turn next to independent claim 19. Unlike other

independent claims, claim 19 does not recite selectivity or the

meta-tagging of search queries relating to documents. Claim 19,

as broadly drafted, recites, "a. providing an element for

extracting terms in search queries presented to a search engine

over a period of time; and b. presenting those terms to a user."

From the language of claim 19, we find that the claim is met

by displaying to the user the search terms used in a search and

the revised search terms from a second search. From the

disclosure of Brunner that narrowed search query constraints are

searched in the local database rather than the remote database

(col. 4, lines 54-60) we find that the system of Brunner will

inherently display to the user the search queries of the initial

search and the narrowed search. Accordingly, we find that

Brunner anticipates claim 19.

We turn next to claim 20. The claim does not require

selectivity, and recites meta-tagging in a conditional manner,

i.e., that a document is meta-tagged _if_ the document is

determined to contain subject matter related to the search term.

From our review of claim 20, we find that the determining

step is conditional, and does not occur when the document is

determined to not have subject matter relating to the search

term. We further find that the determining step reads on the

step being performed by a user. This claim construction is

consistent with the language of appellant's specification (page

16) which discloses that when an author desires to index his own

document, the author will consider each term at the top x percent

of the database, and if the term is relevant to the author's

document, that term will be added to the document as a meta-tag.

Thus, we find that claim 20, as broadly drafted, is anticipated

by the user determining that the document is not related to the

subject matter of the search term, and not adding a meta-tag to

the document. We are not persuaded by appellant's assertion

(brief, page 11) that "if relatedness is determined, the examiner

still does not show where Brunner even suggests "adding said term

to said document" as recited by claim 20. We observe that claim

20 does not recite "adding the term to the document" as asserted

by appellant. From all of the above, the rejection of claim 20

under 35 U.S.C. § 102(e) is affirmed.

We turn next to independent claim 25. We affirm the rejection of claim 25 under 35 U.S.C. § 102(e) for the same reasons as we affirmed the rejection of claim 19.

CONCLUSION

To summarize, the decision of the examiner to reject claims

1-18, 21-24, and 26 under 35 U.S.C. § 102(e) is reversed. The

decision of the examiner to reject claims 19, 20 and 25 under 35

U.S.C. § 102(e) is affirmed.

No time period for taking any subsequent action in

connection with this appeal may be extended under 37 CFR § 1.136
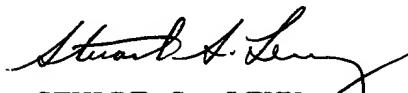
(a).

AFFIRMED-IN-PART

LEE E. BARRETT   )
Administrative Patent Judge   )
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)
) BOARD OF PATENT
JOSEPH L. DIXON   )   APPEALS
Administrative Patent Judge   )   AND
) INTERFERENCES
)
)
)
STUART S. LEVY   )
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